



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,969	04/20/2001	Nir Kossovsky	M-7529-5C US	5316

7590 04/28/2005

FABIO E. MARINO  
BINGHAM MCCUTCHEN LLP  
THREE EMBARCADERO CENTER, SUITE 1800  
SAN FRANCISCO,, CA 94111

EXAMINER
----------

PATEL, JAGDISH

ART UNIT	PAPER NUMBER
----------	--------------

3624

DATE MAILED: 04/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/839,969	<b>Applicant(s)</b> KOSSOVSKY ET AL.	
	<b>Examiner</b> JAGDISH PATEL	<b>Art Unit</b> 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 11-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 11-43 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 11-16, 22-27 and 33-38 are drawn to system, a method, and apparatus for enabling an intellectual property exchange by generating a valuation of an intellectual property asset based on call option pricing theory, information about the intellectual property asset and the information about the publicly traded securities according to technology classification.
- II. Claims 17-18, 28-29 and 39-40 are drawn to system, a method, and apparatus for a method, for enabling an intellectual property exchange by translating quantitative information about attributes of a technology described by an intellectual property asset from user defined units to standard scientific units and storing information about the intellectual property asset in a database associated with the intellectual property exchange, which information

Art Unit: 3624

comprises the user defined units and the quantitative information in standard scientific units.

III claims 19, 30 and 41 are drawn to system, a method, and apparatus for enabling an intellectual property exchange wherein the intellectual property rights are transferred from a seller to a buyer are transferred using an escrow service subsequent to receiving an acceptance of a bid from a seller of the intellectual property rights.

IV. Claims 20, 31 and 42 are drawn to system, a method, and apparatus for enabling an intellectual property exchange based upon an index of market value corresponding to the technology classification as an average of enterprise values of the companies, using information about companies stored in a database.

And

V. Claims 21, 32 and 43 are drawn to system, a method, and apparatus for enabling an intellectual property exchange based obtaining qualification information from potential buyers and sellers and allowing only qualified buyers and sellers to exchange intellectual property rights.

Art Unit: 3624

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I-V are related as subcombinations disclosed as usable together in a single combination.

The subcombinations are distinct from each other if they are shown to be separately usable.

In the instant case,

-- Invention I has separate utility such as generating a valuation of an intellectual property asset based on call option pricing theory, information about the intellectual property asset and the information about the publicly traded securities according to technology classification,

-- Invention II has separate utility such as translating quantitative information about attributes of a technology described by an intellectual property asset from user defined units to standard scientific units and storing information about the intellectual property asset in a database associated with the intellectual property exchange, which information comprises the user defined units and the quantitative information in standard scientific units,

--Invention III has separate utility such as transferring intellectual property rights from a seller to a buyer using an escrow service subsequent to receiving an acceptance of a bid from a seller of the intellectual property rights,

Art Unit: 3624

--Invention IV has separate utility such as computing an index of market value corresponding to technology classification as an average of enterprise values of the companies using information about companies stored in a database, and

--Invention V has separate utility such as obtaining qualification information from potential buyers and sellers and allowing only qualified buyers and sellers to exchange intellectual property rights.

See MPEP § 806.05(d).

3. Because these inventions are distinct for the reasons given above and the different search is required for each Group, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. A telephone call was made to Agent Roberta P. Saxon (Reg 43,087) on 4/20/05 to request an oral election to the above restriction requirement, but did not result in an election being made.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Art Unit: 3624

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

8. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

#### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

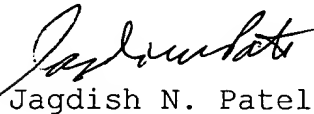
Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be

Art Unit: 3624

reached on (571)272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-0315.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3624)

4/21/05